

REMARKS

This paper is responsive to an Office Action mailed on January 11, 2006. Prior to this response claims 1-2, 4-14, and 16-27 were pending. Claims 1-2, 4-14, and 16-27 remain pending.

In Section 3, the Office Action states that claims 1-2, 4-14, and 16-27 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Mazzagatte et al. ("Mazzagatte"; US 6,862,583) in view of Kocher (US 6,188,766) and Weschler (US 6,652,047). With respect to claims 1, 13, 14, and 26-27 the Office Action acknowledges that neither Kocher nor Mazzagatte describe the storage of profiles in a directory. The Office Action states that Weschler describes directories that are data structures with information such as addresses and public key information (col. 4, ln. 22-26, and col. 5, ln. 13-33). The Office Action states that the combination of Mazzagatte and Kocher teaches a profile which includes "the transmission protocol having an encryption field", and that it would have been obvious to add Weschler to the combination "to store the profiles in the directory because a directory indicates where the profile is located for profile services which includes search and retrieve methods for accessing existing profiles". This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck* 947 F.2d 488, 20 USPQ2d, 1438 (Fed. Cir. 1991).

Mazzagatte creates a print job at a sending node, i.e., a desktop computer 10 print driver (col. 7, ln. 46-55). The sending node submits the job to a print node along with unique identification information (col. 8, ln. 19-29). The print node encrypts and stores the print job after it is received (col. 8, ln. 62-67). After the user arrives at the print node and presents their unique user identification information, the print node decrypts the print job and prints it (col. 9, ln. 26-35).

As acknowledged in the Office Action at page 4, Kocher discloses a standard fax machine, which is capable of transmitting a scanned document (col. 4, ln. 35-55). The patent's novelty appears to be that faxed documents are sent to a timestamping service, which maintains an archive of timestamped fax documents (Abstract).

Weschler describes a secure data record storage mechanism (Abstract). In his Background Section, Weschler states that directories are a problematic method of finding resources in a distributed system, as directories contain duplicate information and are difficult to maintain (col. 4, ln. 22-30). At col. 5, ln. 10-35, Weschler describes a prior art Domain Name System (DNS), which uses a Lightweight Directory Access Protocol (LDAC) to make domain name searches. At col. 10, ln. 59-67, Weschler describes a core profile engine that maintains a set of meta-data about

every profile. The meta-data controls how the core profile engine makes profile data available to client applications.

With respect to the *first prima facie* requirement, the Office Action fails to provide any motivation to combine references in a manner that suggests the claimed invention. Since Mazzagatte describes the use of the SSL protocol to send encrypted print jobs, the combination of Mazzagatte with Kocher may suggest a service that saves timestamped print jobs, as a means of verifying that the jobs were sent. Alternately, the combination may suggest fax jobs sent using an SSL transmission protocol. This combination is not at all close to the claimed invention, where a scanning device uses a profile with fields for the selection of a destination address and encryption format. Even if Weschler's directory is added to the combination, the combination does not suggest the Applicant's recitation of profile. That is, the combination of references does not describe the process of selecting a profile, where the profile gives directions as to how a scanned document is to be encrypted and the destination address to which the encrypted document is to sent.

The three references appear to be combined as a result of a retrospective analysis, by performing a search that uses the Applicant's claim limitations as keywords. The Applicant respectfully submits that a timestamp repository for fax documents suggest few modifications to a print driver. Likewise, a data architecture whose novelty is in keeping a single copy of a data record appears to offer no modifications to either a fax device or a print driver. "It is impermissible to reconstruct the claimed invention from selected pieces of prior art absent some suggestion, teaching, or motivation in the prior art to do so. *Interconnect*

Planning Corp. v. Feli, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985).

More specifically, the Office Action states that the combination of Mazzagatte and Kocher teaches a “profile which includes the transmission protocol having an encryption field”. The Office Action also states that that Mazzagatte, at col. 6, ln. 15-18, describes selecting profile having an encryption field. However, this passage of Mazzagatte reads as follows:

“Encryption/decryption logic 355 enables printer 50 to receive encrypted data according to the present invention and to carry out the necessary steps to enable the decryption of the encrypted print data in the presence of an intended recipient.”

No mention is made in this passage of a profile, or of a profile having an encryption field. There appears to be absolutely no connection between a printer capable of receiving encrypted data (Mazzagatte) and a fax machine that timestamps messages (Kocher). Even if Mazzagatte and Kocher are combined, that combination is still absolutely silent with respect to profiles. Further, a profile which includes a transmission protocol and an encryption field is not the same as the Applicant’s recited profile that includes an address field and an encryption field.

The Office Action also states that it would have been obvious to add Weschler to the combination of Mazzagatte and Kocher “to store the profiles in the directory because a directory indicates where the profile is located for profile services which includes search and retrieve methods for accessing existing profiles”, citing col. 10, ln. 55-57 of Weschler. This passage of Weschler reads as follows:

"First, the profile services API 303 provides "factory" methods for creating profiles. Second, the profile services API 303 provides search and retrieve methods for accessing existing profiles. Third, the profile services API 303 provides management utilities for defining schemas."

Earlier (col. 8, ln. 29-38), Weschler provides the following definitions:

"Profile--A collection of attributes related either directly or indirectly to a EntityProfile that represents some sort of entity such as a user.

EntityProfile--A collection of attributes that establish the root of a profile tree and serve as the base representation of some entity. This is the core data object around which the entire Profile Service is designed to function. In an object oriented sense, an EntityProfile extends a Profile to add special functions and behavior."

First, Weschler's treatment of the term profile is not consistent the Applicant's definition of the term. For example, Weschler does not describe profile address or encryption fields. Second, there is no suggestion in Weschler to make modifications to a printer capable of decrypting documents (Mazzagatte), or to a time-stamping fax machine (Kocher).

The Affidavit of Burton Levin is submitted herewith to support the Applicant's assertions. It is Mr. Levin's position that there is no suggestion or motivation to combine the prior art references. In fact, the Mazzagatte reference can even be said to point away from the claimed invention. As explained in more detail in Mr. Levin's affidavit,

Mazzagatte handles secure (SSL protocol) documents without the use of header information.

With respect to the second *prima facie* requirement, even if an expert were given the Mazzagatte, Kocher, and Weschler references as a foundation, no insight has been provided in the Office Action or in the references themselves as to how this expert would come up with the claimed invention. The combination of references does not provide an expectation of success that a scanning device can be established with a directory that permits scan jobs to be automatically encrypted and sent to an address in response to selecting a profile from the directory.

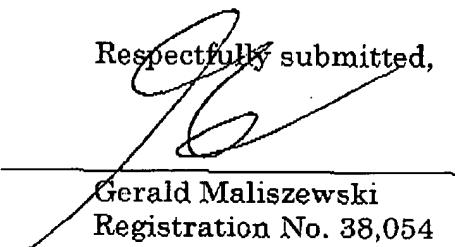
With respect to the third requirement to support a *prima facie* case of obviousness, the combination of references does not teach all the limitations of claims 1, 13, and 14. None of the cited references describes the selection of a profile, where a profile is a computer text file that includes an address field and an encryption field. None of the cited references describe the encryption of a scanned document using the encryption field of the selected profile. None of the references describe sending the encrypted documents to a destination using the address field of the selected profile. All of the above-mentioned features are recited in claims 1, 13, and 14 of the claimed invention. Therefore, the combination of the Kocher, Weschler, and Mazzagatte does not explicitly describe all the elements of claims 1, 13, and 14. Neither do the references suggest any modifications that make these claims obvious. Claims 2, 4-12, dependent from claim 1, and claims 16-25, dependent from claim 14, enjoy the same distinctions, and the Applicant respectfully requests that the rejection be removed.

With respect to claims 26 and 27, none of the refers explicitly describes encryption fields that are cross-referenced to address fields, or the transmission of an encrypted document to a destination responsive to a selected address field. Neither do the combination of references suggest any modifications that make these missing limitations obvious, and the Applicant requests that the rejection be removed.

It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

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Respectfully submitted,



Gerald Maliszewski
Registration No. 38,054

Customer Number 55,286
P.O. Box 270829
San Diego, CA 92198-2829
Telephone: (858) 451-9950
Facsimile: (858) 451-9869
gerry@ipatentit.net